APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,657	06/29/2001	Victor R. Herrero	POU920010051US1	8494

			EXAMINER
23334	7590	02/10/2005	ROCHE, TRENTON J

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ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/896,657	HERRERO, VICTOR R.
		Examiner	Art Unit
		Trent J Roche	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15 and 17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15 and 17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 June 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

           application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is responsive to communications filed 14 October 2004.

2.   Per applicant's request, amended claims 1-7, 9-15 and 17 have been entered. Claim 16 has

been canceled. Claims 1-15 and 17 are pending.

3.   Claims 1-15 and 17 have been examined.

Response to Amendment

4.   The declaration filed on 14 October 2004 under 37 CFR 1.131 is sufficient to overcome the

Kelley et al. reference.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-15 and 17 have been considered but are moot

in view of the new ground(s) of rejection.

Claim Rejections – 35 USC § 112

6.   In light of the applicant's amendments regarding claims 9 and 15, the rejection under 35

USC § 112 2nd paragraph has been withdrawn.

Claim Rejections – 35 USC § 101

7.   In light of the applicant's cancellation of claim 16, the rejection under 35 USC § 101 has

been withdrawn.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1, 3-12, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent 5,715,314 to Payne et al., hereafter referred to as Payne, in view of U.S. Patent 5,845,077

to Fawcett.

Per claim 1:

Payne discloses:

- a method on a client server network for the ordering, downloading, and installation of

    products (Note Figure 1 and the corresponding sections of the disclosure.)

- presenting to a user a list of products on a client system; receiving a user selection for

    ordering at least one product from the list of products on a product ordering server (Note

    Figure 2A, item 30, 32 and 34 and the corresponding sections of the disclosure)

- receiving a response to the order for at least one product from the product ordering server,

    the response includes an entitlement ID for authorizing the use of the product, wherein the

    entitlement ID is sent from the product ordering server to the product delivery server ("The

    payment computer is programmed to received the payment message, to cause an access

    message to be created that comprises the product identifier and an access message

authenticator based on a cryptographic key, and to cause the access message to be sent to

the merchant computer..." in col. 1 lines 59-64)

- requesting a download copy of the at least one product from the product delivery server, the

    request includes the entitlement ID previously received from the product ordering server

    (Note Figure 2H, item 92 and the corresponding sections of the disclosure)

- receiving, in response to the entitlement ID received from the product ordering server

    matching the entitlement ID received with a request for the download copy, the copy of the

    at least one product from a scheduling server as part of a payload ("to cause the product to

    be sent to the user desiring to buy the product..." in col. 2 lines 1-2)

substantially as claimed. Payne does not explicitly disclose that the product is software, nor does

Payne disclose the installation of the software product after receiving the software product, nor the

inclusion of an installation script. Fawcett discloses a system enabling a user to view and purchase

software for installation and to automatically install the application independently of the user ("a

user selection of desired software..." in col. 11 lines 60-61. Further, "downloading the desired

software to the first computer, and installing the desired software on the first computer..." in col.

12 lines 42-44. The installation is performed automatically, as shown in col. 10 lines 49-54.) It would

have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the

product distribution system of Payne to allow software distribution and installation as described by

Fawcett, as this allow a user to purchase and install software easily via the Internet without the

burden of obtaining software from a physical retailer.

Per claim 3:

The rejection of claim 1 is incorporated, and further, Payne does not explicitly disclose sending

system information as claimed. Fawcett discloses the ability to send system information as claimed

(Note at least Figure 4A, item 70 and the corresponding sections of the disclosure). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to send system

information as disclosed by Fawcett to a product distribution server as disclosed by Payne, as this

would allow the product server to identify new computer software, patches, and fixed required by

the client, as disclosed by Fawcett in col. 7 lines 23-44.

Per claim 4:

The rejection of claim 1 is incorporated, and further, Payne does not explicitly disclose the ordering

of the software file from the software ordering server only when the software file is needed for use.

Fawcett discloses the downloading of software files only when the software files are needed

("indicating software available…and not installed on the user computer…an alert about a defect in

software on the user computer correctable by software available…" in col. 13 lines 3-8). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have the

product ordering system disclosed by Payne order only when a software file is required as disclosed

by Fawcett, as this would increase user productivity by not requiring the user to constantly check for

software updates.

Per claims 5-8:

The rejection of claim 1 is incorporated, and further, Payne does not explicitly disclose that the

installation of the received copy of the at least one software file requires no further intervention

from the software ordering server, requires no client user intervention, does not allow any choices or

options by a user, and obviates the need for help to install as claimed. Fawcett discloses an automated installation process requiring no further intervention from the ordering server, a user, or additional help ("With automatic downloading and installation of computer software from the update service, the user is relieved from the burden of obtaining software…and installing the computer software on the user computer." in col. 10 lines 49-56. The automated installation sequence inherently would not require user intervention, allow user choices, and obviate the need for help to install.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an automated installation system as disclosed by Fawcett in the product ordering system disclosed by Payne, as this would relieve the burden of obtaining computer software and installing the computer software on the user, thereby simplifying computer use, as disclosed by Fawcett in col. 10 lines 50-53.

Per claim 9:

Payne discloses:

- a method on a client server network for the selection, download, and installation of products (Note Figure 1 and the corresponding sections of the disclosure.)

- receiving from a software ordering server, an entitlement ID for authorizing the use of the product which has been previously ordered on a client system ("The payment computer is programmed to received the payment message, to cause an access message to be created that comprises the product identifier and an access message authenticator based on a cryptographic key, and to cause the access message to be sent to the merchant computer…" in col. 1 lines 59-64. Further, note Figure 2F, item 86 and the corresponding sections of the disclosure.)

- receiving a request from the client system for the download of a copy of the at least one

  product to the client system, wherein the request includes an entitlement ID used to order

  the software file (Note Figure 2H, item 92 and the corresponding sections of the disclosure)

- verifying that the entitlement ID received from the ordering server matches the entitlement

  ID used to order the at least one software file (Note Figure 2H, item 94 and the

  corresponding sections of the disclosure)

- scheduling the download of the requested product to the client system ("to cause the

  product to be sent to the user desiring to buy the product..." in col. 2 lines 1-2)

substantially as claimed. Payne does not explicitly disclose that the product is software, nor does

Payne disclose verifying the client system's PC compatibility for the requested copy of at least one

software file. Fawcett discloses a system enabling a user to view and purchase software for

installation and checking the client system's PC compatibility as claimed ("a user selection of desired

software..." in col. 11 lines 60-61. Further, note Figure 4A, item 72 and the corresponding sections

of the disclosure.). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to utilize the product distribution system of Payne to allow software distribution

and installation as described by Fawcett, as this allow a user to purchase and install software easily

via the Internet without the burden of obtaining software from a physical retailer.

Per claim 10:

The rejection of claim 9 is incorporated, and further, Kelley discloses requesting the client system's

PC platform type, available storage, installed software, and verifying that one or more responses to

the requests are within allowable limits as claimed (Note paragraph 0042. The system inherently

verifies that the patch will work before installing.)

Per claim 11:

Payne discloses:

- a method on a client server network for the ordering, downloading, and installation of

  products (Note Figure 1 and the corresponding sections of the disclosure.)

- receiving an order entitlement ID for at least one product, which has been previously

  ordered from a client system on a product ordering server ("The payment computer is

  programmed to received the payment message, to cause an access message to be created that

  comprises the product identifier and an access message authenticator based on a

  cryptographic key, and to cause the access message to be sent to the merchant computer..."

  in col. 1 lines 59-64. Further, note Figure 2F, item 86 and Figure 2H, item 92, and the

  corresponding sections of the disclosure.)

- storing the entitlement ID for at least one product in a database ("merchant database..." in

  col. 3 line 3)

- receiving a request for the down-load of at lest one requested product with a download

  entitlement ID from a client system (Note Figure 2H, item 92 and the corresponding

  sections of the disclosure)

- determining if the downloaded entitlement ID matches the order entitlement ID previously

  stored in the database, and in response to the order entitlement ID matching the download

  entitlement ID; and scheduling a response to the request for a copy of the at least one

  product at a scheduling server (Note Figure 2H, item 94 and the corresponding sections of

the disclosure. Further, "to cause the product to be sent to the user desiring to buy the

product..." in col. 2 lines 1-2)

substantially as claimed. Payne does not explicitly disclose that the product is software, nor does

Payne disclose the installation of the software product after receiving the software product. Fawcett

discloses a system enabling a user to view and purchase software for installation and to automatically

install the application independently of the user ("a user selection of desired software..." in col. 11

lines 60-61. Further, "downloading the desired software to the first computer, and installing the

desired software on the first computer..." in col. 12 lines 42-44.).It would have been obvious to one

of ordinary skill in the art at the time the invention was made to utilize the product distribution

system of Payne to allow software distribution and installation as described by Fawcett, as this allow

a user to purchase and install software easily via the Internet without the burden of obtaining

software from a physical retailer.

Per claim 12:

Claim 12 is directed to a computer readable medium containing programming instructions for

performing the method of claim 1, and is rejected for the reasons set forth in connection with claim

1.

Per claim 14:

The rejection of claim 12 is incorporated, and further, note the rejection regarding claim 3.

Per claim 15:

Claim 15 is directed to a computer readable medium containing programming instructions for performing the method of claim 11, and is rejected for the reasons set forth in connection with claim 11.

Per claim 17:

Payne discloses:

- a software delivery server coupled to a client server network (Note Figure 1 and the corresponding sections of the disclosure)

- a network interface for coupling at least one client system (Note Figure 1 and the corresponding sections of the disclosure)

- an order entitlement ID received over the network interface for at least one product, which has been previously ordered from the at least one client system on a product ordering server (Note Figure 2F, item 86 and Figure 2H, item 92, and the corresponding sections of the disclosure.)

- a download request received over the network interface from at least one of the one or more client systems for a copy of the at least one software file, wherein the request includes an order entitlement ID for at least one product (Note Figure 2H, item 92 and the corresponding sections of the disclosure)

- a database used to store the entitlement ID for at least one product ("merchant database..." in col. 3 line 3)

- receiving a request for the download of at least one requested product file with a download entitlement ID from a client system (Note Figure 2H, item 92 and the corresponding sections of the disclosure)

- means for determining if the download entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID, scheduling a response to the request for a copy of at least one product at a scheduling server (Note Figure 2H, item 94 and the corresponding sections of the disclosure. Further, "to cause the product to be sent to the user desiring to buy the product..." in col. 2 lines 1-2)

10.   Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,715,314 to Payne et al., hereafter referred to as Payne, in view of U.S. Patent 5,845,077 to Fawcett, further in view of U.S. Patent Publication 2002/0128975 A1 to Klemba et al., hereafter referred to as Klemba.

Per claim 2:

The rejection of claim 1 is incorporated, and further, neither Payne nor Fawcett explicitly disclose receiving a request for acceptance of a software license agreement, and sending the acceptance to the software delivery server. Klemba discloses in an analogous client/server software distribution system the act of requesting acceptance of a software license agreement, and sending the acceptance to the software delivery server as claimed ("upon agreement of the EULA..." in paragraph 0037). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the license agreement ability of Klemba with the software distribution system of Payne, modified by Fawcett, as this would enable a vendor to impose legal standards on the to-be installed software in the system of Payne, modified by Fawcett.

Per claim 13:

The rejection of claim 12 is incorporated, and further, note the rejection regarding claim 2.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the date of this final action.

13.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Trent J Roche whose telephone number is (571)272-3733. The examiner can

normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Kakali Chaki can be reached on (571)272-3719. The fax phone number for the organization where

this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trent J Roche
Examiner
Art Unit 2124

TJR

KAKALI CHAKI
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